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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,268	02/19/2002	Ronald Turfitt	LARUE-8	6966

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EXAMINER

GOODMAN, CHARLES

ART UNIT PAPER NUMBER

3724

DATE MAILED: 10/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/080,268

Applicant(s)

TURFITT, RONALD

Examiner

Charles Goodman

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 September 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: the arguments are not persuasive. Note the attached comments.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1,2 and 4-11.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See Continuation Sheet

Continuation of 10. Other: The "Amendment" has been entered to the extent that the claims are the same as previously presented in the last Amendment, and therefore cannot be construed as new issues..

DETAILED ACTION

1. Receipt is acknowledged of the Request for Reconsideration filed on 9/16/04. It has been entered, and the response follows *infra*.
2. The Amendment to the claims in the Request for Reconsideration has been entered to the extent that they are the same claims presented in the last Amendment filed on 3/18/04.
3. In response to Applicant's basic argument that the PCD and CBN saw tips are not equivalent in the art as the Examiner characterized in the last Office Action, this argument is traversed.

Applicant's argument is basically couched in the assertion that PCD tips react chemically, i.e. adversely, with iron and steel and cannot be used to machine any steel alloy. However, this fails to persuade for several reasons.

First, notwithstanding Applicant's assertion, there is no convincing evidentiary proof in the Application that during routine operation of a PCD tipped saw blade, the PCD tipped saw blade would not operate substantially the same in sawing a wood board that may contain the occasional nail, i.e. iron and steel. In other words, the statement that Applicant refers to in the specification would lead one skilled in the art to read that PCD tipped saw blades should not be used in *primarily* sawing (or machining) steel alloys, not wood or wood products. Due to the ultra-hard nature of PCD tips, the occasional nail that may be contained in a wooden board would not be a detriment to the ordinary artisan in using a PCD tipped saw blade to saw through the same. The Examiner has previous experience in the wood cutting industry, and even with conventional saws, i.e. ones using tungsten carbide tips or equivalents thereof, there was no appreciable adverse effect when sawing through pallet material containing the occasional nail(s).

Second, the preamble of claim 1, "...occasional cutting exposure to ferrous materials", is relating to the intended use of the claimed device, and therefore lacks patentable weight. Any arguments relating to the work must fail for this reason alone, since the intended use recitation does not breathe any "life and meaning" to the claimed device when the body of the claim stands alone without the intended use.

Third, the declaration filed on May 25, 2004 has already been addressed. The higher cost issue is not sufficient evidence of unobviousness, since as in most industries, there are a number of different grades within a product line-up catering to the various needs (and affordability) of the consumer, e.g. generic and species or low end to high end. Even if one product, e.g. CBN, may cost more than the other, e.g. PCD, both are deemed to be fall under the general ultra-hard tipped saws. Moreover, based upon the teachings of the Admitted Prior Art, either tipped saw blades are known in the art which shows that the technical know how exists for both kinds of tips. Commercial viability (or success) is not the issue here in determining patentability. As for the declarant's statement of how well the invention cuts through ferrous materials, again it is emphasized that such statement reaffirms the intent of the invention. It does not address why it would not be obvious to substitute one for the other especially when the resultant saw is primarily used to cut wood. To be clear, on the one hand, the work is not determinative of patentability. On the other hand, since both the Admitted Prior Art and Felde teach using their respective saws in cutting wood or wood products, it is the Examiner's position that either tips are equivalent.

Fourth, with respect to Applicant's argument of claim 10, the Examiner cited various passages in the specification, the Admitted Prior Art, which teaches grinding of the tip. The

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slower rate is obvious to the ordinary artisan in that the ultra-hard material is by its very nature harder than tungsten carbide. Therefore, one of ordinary skill in the art would not grind the harder material using the same machinery for tungsten carbide at the same rate as one would tungsten carbide since that would wear out the grinder much faster. It is known in the art to utilize a slower rate of grind for harder materials since the harder material does not lend itself to be ground at the same rate as that of a softer material when using the same grinding machinery for both, i.e. for a given grinder, the rate of material wear is inversely proportional to the hardness of the material being ground, faster for soft and slower for hard.

Fifth, in response to Applicant's argument with respect to claim 2, it appears that Felde teaches the tip having the combination of tungsten carbide and ultra-hard material. Moreover, it appears that the Admitted Prior Art also teaches the same in p. 3, ll. 17-18, "In practice, thin layers of PCD or CBN are *bonded* to a disk of *tungsten carbide substrate*..." (emphasis added).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Goodman whose telephone number is 703-308-0501. The examiner can normally be reached 7:30-6:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 703-308-1082. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Charles Goodman
Primary Examiner
AU 3724

cg 
October 17, 2004

CHARLES GOODMAN
PRIMARY EXAMINER